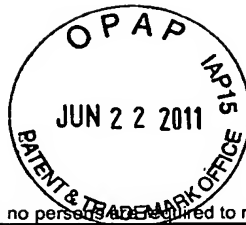


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PTO/SB/33 (07-09)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

46500-000578/US

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Typed or printed name _____

Application Number

10/766,211

Filed

January 29, 2004

First Named Inventor

Kang Soo Seo, et al.

Art Unit

2481

Examiner

H. Jones

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 35,416

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature

Gary D. Yaoura

Typed or printed name

(703) 668-8000

Telephone number

June 22, 2011

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
46500-000578/US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANTS: Kang Soo Seo, et al. CONF. NO.: 3350
APPLN. NO.: 10/766,211 ART UNIT: 2481
FILED: January 29, 2004 EXAMINER: H. Jones
FOR: RECORDING MEDIUM HAVING DATA STRUCTURE FOR MANAGING
REPRODUCTION DURATION OF STILL PICTURES RECORDED
THEREON AND RECORDING AND REPRODUCING METHODS AND
APPARATUSES

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Mail Stop Appeal

June 22, 2011

REASONS FOR PRE-APPEAL REQUEST FOR REVIEW

Dear Sir:

Appellants hereby request review of the March 22, 2011 Final Rejection of this application. Claims 13, 18, 24-27 and 56 are pending in this application. Claims 13, 24-27 and 56 are the independent claims. Appellants seek the panel's review of the rejection of claims 13, 18, 24-27 and 56 under 35 U.S.C. § 103(a) as being unpatentable over Kato et al. (U.S. Patent Publication 2002/0145702, hereinafter "Kato") in view of Ando et al. (U.S. Patent No. 7,054,545, hereinafter "Ando") in view of Seo et al. (U.S. Patent Publication No. 2001/0056580, hereinafter "Seo") in view of Jung et al. (U.S. Patent Publication 2004/0081434, hereinafter "Jung") because of clear errors in the Examiner's rejection and/or the Examiner has omitted one or more essential elements needed for a prima facie rejection.

I. Not obvious to combine Ando with Kato, Jung and Seo

Appellants submit that it is not obvious to combine the teachings of Ando (e.g., older DVD art) with Kato, Jung and Seo (e.g., high density recording mediums). In addition, if one of ordinary skill in the art would "try" to combine the teachings of Ando with the teachings of Kato, Jung and Seo, the data structure of Kato and Jung would have to be "substantially modified" in order to implement the features of Ando to achieve the

claimed invention.¹ However, this substantial modification may be considered an inventive step in itself. In other words, this is not a situation where “some features” from Ando can be merely substituted into the data structure of Kato and Jung. For a detailed discussion of this argument, Appellants direct the attention of the Pre-Appeal Panel to Appellants’ May 5, 2011 Request for Reconsideration at pages 10-11.

For example, the claimed invention relates to the recordation and reproduction of still image units and audio data using the specific data structure of the playitem, the sub-playitem, and the still picture unit. Although Kato and Jung teach the *general concept* of a playlist file (including a playitem and sub-playitem) and a stream file, Kato and Jung fail to teach the *details* of the playitem such as the first and second duration information, the *details* of the first and second stream files (e.g., the first stream including presentation data, the second stream including audio data, the presentation data being divided into still picture unit, the still picture unit including a still picture and graphic data), the synchronous reproduction of the still picture and graphic data based on the playitem, and the independent reproduction of the still picture unit and the audio data based on the sub-playitem.

Rather, the Examiner relies upon the older DVD art of Ando as teaching most of these features, which uses a different file structure. For example, Ando uses VTSI information, navigation packs, audio/visual packs, and program chains (PGC), which are different than the features of Kato and Jung, as well as the claimed invention. In order to accommodate the features relied on by the Examiner from Ando into the data structure of Kato and Jung, one of ordinary skill in the art would have to substantially modify the data structure (playlist file/stream file) of Kato and Jung, which is not obvious to one of ordinary skill in the art.

As explained in the May 24, 2011 Advisory Action, the Examiner disagrees with the above position because the Examiner states that Ando is in the same field of endeavor as Kato, Jung and Seo, which “all have to do with recording video and audio on a disk.”² Even assuming that this is true for the sake of argument, Appellants *are* arguing that it would *not* be *obvious* to combine the teaching of Ando into the data structure of Kato and Jung because it would not yield predictable results due to their data structures being so different. Appellants *are not* arguing that Ando is in a different field of endeavor and therefore should not even be considered by the Examiner in the Section 103 analysis. As

¹ Seo does not illustrate a data structure recorded on a recording method.

² See May 24, 2011 Advisory Action at page 2.

such, the Examiner has not addressed this argument (e.g., explaining how the data structure of Kato may be modified without the benefit of Appellants' disclosure).

II. Cited References do not teach the "still picture unit" of claim 13

Claim 13 requires that a still picture unit include 1) at least one still picture and 2) associated graphic data. Further, claim 13 requires that the still picture unit is included in the first stream file and the audio data is included in the second stream file. The Examiner acknowledges that Kato does not illustrate these features.³ Also, in contrast to the Examiner's assertions, Jung and Seo, alone or in combination, do not teach the above features of the still picture unit, for the reasons discussed below. For a detailed discussion of this argument, Appellants direct the attention of the Pre-Appeal Panel to Appellants' May 5, 2011 Request for Reconsideration at pages 11-13.

FIG. 18 of Jung clearly illustrates that the clip (AV stream) file is recorded in a separate file from the sub-title (text) file. Therefore, Jung cannot possibly teach a unit within one file including the still picture and the graphic data. As a result, Jung does not teach the still picture unit including at least one still picture and associated graphic data, and the still picture unit is included within a first stream file, as required by claim 13.

In the Final Office Action, the Examiner cites to paragraph [0006] of Seo as allegedly disclosing the above-identified features of claim 13.⁴ However, this portion of Seo teaches a graphic generator (which generates the graphic data), which is separately provided in the MPEG decoder. The graphic data and the picture data are then outputted to the monitor after *mixing* the graphic data and the picture data. The fact that Seo actually "generates" graphic data and then "mixes" the graphic data and the picture data immediately before displaying them overwhelmingly demonstrates that the graphic data of Seo is not recorded with the picture data in the recording medium.

On pages 2-3 of the Advisory Action, the Examiner provides a somewhat different theory on how Seo supposedly teaches a still picture unit that includes image data and graphic data. In this portion of the Advisory Action, the Examiner alleges that *now* paragraph [0039] of Seo allegedly teaches the still picture unit of claim 13. When viewing paragraph [0039] with FIG. 6, it is clear that Seo teaches a data structure that includes a plurality of Transport Packets (TPs). Each TP includes either A/V data or presentation data. One TP does not include both A/V data and presentation data. A TP may be considered one "unit." For example, Seo directly states that "each TP has Packet Identifier

³ See Office Action, page 3.

⁴ See Office Action, page 6.

(called 'PID' hereinafter) to differentiate an A/V data TP from ATVEF data TP one."⁵ As such, interpreting Seo as allegedly teaching a still picture unit that includes graphic data and a still picture is simply not consistent with the plain language of the reference.

Also, the Examiner states "[f]urthermore, [p]aragraph [0006] discloses that the packets are all separated and then displayed synchronously."⁶ This is misleading. The prior art method discussed in paragraph [0006] of Seo is completely different than Seo's device, which is discussed in paragraph [0039]. For example, the prior art method in paragraph [0006] teaches a graphic generator (that generates the graphic data), which is separately provided in the MPEG decoder. The graphic data and the picture data are then outputted to the monitor after *mixing* the graphic data and the picture data. In contrast, Seo's device in paragraph [0039] teaches a data structure that includes a plurality of Transport Packets (TPs). Each TP includes either A/V data or presentation data. In other words, Seo's device is directed to providing presentation data from the recording medium itself. The Examiner's suggestion that the "packets" of paragraph [0039] are separated and displayed according to paragraph [0006] is not correct.

III. Cited References fail to teach the graphic data and the still picture being included in a still picture unit in one file and managed by a playitem and the audio data in a separate file and managed by a separate playitem of claim 13

For a detailed discussion of this argument, Appellants direct the attention of the Pre-Appeal Panel to Appellants' May 5, 2011 Request for Reconsideration at pages 13-14.

Because Jung does not disclose the "still picture unit" of claim 13 as discussed above, Jung cannot possibly disclose the at least one still picture and associated graphic data in the still picture unit being reproduced synchronously based on the at least one playitem, as required by claim 13. For example, in FIG. 18 of Jung, the subtitle data is recorded in a separate file from the clip storing AV stream file. Although Jung may *generally* teach the synchronization of video data and graphic data, claim 13 is not merely directed to the synchronizing the video data and the graphic data. Rather, in claim 13, the synchronization of the still picture and the graphic data uses an effective data structure (e.g., the still picture unit).

Also, because Seo does not teach the "still picture unit" of claim 13 as discussed above, Seo cannot possibly disclose the at least one still picture and associated graphic data in the still picture unit being reproduced synchronously based on the at least one

⁵ See Seo, paragraph [0032].

⁶ See Advisory Action, page 3.

playitem. For instance, Seo does not utilize a "playitem" or record the graphic data with the picture data in the manner claimed.

IV. Ando fails to teach the first and second duration information of claim 13

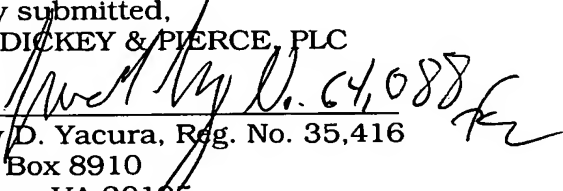
For a detailed discussion of this argument, Appellants direct the attention of the Pre-Appeal Panel to Appellants' May 5, 2011 Request for Reconsideration at page 15. For example, in contrast to the "first duration information" and "second duration information" of claim 13, Ando teaches "MIN_DUR" that indicates the minimum duration and "MAX_DUR" that indicates the maximum duration.⁷ Also, "MAX_DUR" indicates "00h" in the slideshow and both MAX_DUR and MIN_DUR indicate "00h" when the slideshow is presented for infinite duration.

In contrast, the claimed invention determines whether at least one still picture is displayed for a finite period of time or for an infinite period of time when the still pictures are reproduced as the slideshow, and the claimed invention determines a length of time to display the still picture based on the second duration information when the first duration information indicates to display the at least one still picture for a finite period of time. In the claimed invention, if the still picture is displayed for infinite period of time, the claimed invention is able to read only the first duration information, but Ando still has to read both MAX_DUR and MIN_DUR.

Therefore, Appellants submit that Ando, Seo, Kato and Jung, alone or in combination, cannot render independent claim 13 obvious to one of ordinary skill in the art. Independent claims 24-27 and 56 includes features similar to the above-discussed features of claim 13, and are patentable for at least the same reasons stated above. Claim 18, dependent on claim 13, is patentable for at least the same reasons stated above.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,
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⁷ See Ando, column 39 lines 38-59.